

U.S. Application No. 09/844,625
Amendment dated July 5, 2006
In Response to Office Action of April 4, 2006

REMARKS

Claims 1-28 are pending in the present application.

Applicant gratefully acknowledges the indication by the Examiner that claims 6, 8, 9, 14, 15, 21 and 23 recite patentable subject matter.

Claims 1-28 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. In particular, the Examiner asserts that it is unclear what is meant by "electronic system does not have to be aware".

Applicant respectfully submits that that phrase "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device" is easily understood by reading the plain meaning of the language.

Does the electronic system have to be aware of the first protocol to be in communication with the device? No, the electronic system does not have to be aware of the first protocol to be in communication with the device.

Respectfully, which word does the Examiner not understand?

In claim 1, for example, a device communicates according to a first protocol and an electronic system communicates using a second protocol. Normally, one might conclude that the electronic system and the device should not be able to communicate with each other since the device communicates according to a first protocol and the electronic system communicates using a second protocol. But, an interface unit, as set forth in claim 1, effects communication between the device and the electronic system. How can this be? Perhaps the electronic system can communicate according to the first protocol too? No, this is not necessary. Why? Because Applicant has invented an interface to effect communications between the device and the electronic system even when the electronic system is not aware of the first protocol. So even though the device communicates according to the first protocol and the electronic system communicates using the second protocol, the interface unit effects communication. In fact, the electronic system does not have to be aware of the first protocol to be in communication with the device.

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Applicant respectfully submits that the plain language of the claims is very clear. Presumably, the unwritten contention is that the Examiner is presumably uncomfortable with negative claim recitations. Nevertheless, negative recitations are not *per se* indefinite. See, e.g., M.P.E.P. § 2173.05(i) (“[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation”).

In the Office Action, the Examiner states that the claim language “wherein the electronic system does not have to be aware of the first protocol to be in communication with the device” appears to be functional. Is that the basis for the rejection? The Examiner did not clarify this raised issue.

Applicant respectfully submits that this is not functional language. The electronic system is not doing anything in the cite phrase so as to constitute functional language.

Nevertheless, even if the language is functional, for the sake of argument only, *In re Swinchart*, 169 U.S.P.Q. 226 (C.C.P.A. 1971) states clearly that “[w]e are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that ‘functional’ language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of any language, ‘function’ or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. 112”. *In re Swinhart*, 169 U.S.P.Q. at 229.

It is especially noteworthy and persuasive that this is a Court of Customs and Patent Appeals case.

Furthermore, it is noted that claim 11 is a method claim. Is the Examiner alleging that functional language is *per se* improper in a method claim?

It is respectfully requested that the rejection under 35 U.S.C. § 112, ¶ 2, be withdrawn with respect to claims 1-28.

With respect to the rejection of claims 1-5, 7, 10-13, 16-20, 22 and 24-28, Applicant respectfully attaches in an Appendix, the pertinent sections of the Argument section of the Appeal Brief filed January 17, 2006.

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In addition, Applicant respectfully draws the attention of the Examiner to M.P.E.P. § 2173.05(i) which states "[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation". Thus, a lack of positive recitation should not be a bar to patentability and negative limitations should not be ignored.

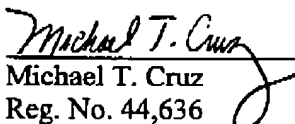
For at least the above, it is respectfully requested that the rejection be withdrawn with respect to claims 1-5, 7, 10-13, 16-20, 22 and 24-28.

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-28 are in condition for allowance. If anything remains in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: July 5, 2006

Respectfully submitted,


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APPENDIX

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ARGUMENT

I. Group I: Claims 1-5, 10-13, 16-20 and 24-27

Claims 1-5, 10-13, 16-20 and 24-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Bork patent.

Independent claims 1 and 24 recite, in part, "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device". Independent claim 11 recites, in part, "the electronic system not having to be aware of the first protocol to be in communications with the device". Independent claim 16 recites, in part, "wherein the personal computer does not have to be aware of the first protocol to be in communication with the device". Appellant respectfully submits that the Bork patent does not describe at least these elements as set forth in independent claims 1, 11, 16 and 24.

In the Office Action Made Final of June 22, 2005 ("the Final Office Action") at page 4, the Examiner states that "the electronic system does not have [to] be aware of the first protocol to be in communication with the device because the protocol translation is performed by the Bluetooth USB Firmware. Since Bluetooth USB firmware is already in place to provide protocol translation, the electronic device does not need to be aware of the first protocol of the device." Final Office Action at page 4.

Appellant respectfully submits that the logical argument presented in the Final Office Action makes assumptions not described in the Bork patent. For example, just because the Bork patent describes a USB driver 62 with Bluetooth USB firmware and a USB device controller, as illustrated in FIG. 19, it does not necessarily follow that the electronic system (which is alleged to be portable computer 70) does not have to be aware of the first protocol (which is alleged to be the Bluetooth protocol). Appellant respectfully notes that the Final Office Action did not provide a citation to the Bork patent which clearly demonstrates that "[s]ince, Bluetooth USB firmware is already in place to provide protocol translation, the electronic device does not need to be aware of the first protocol of the device". See Final Office Action at page 4 (without citation to the Bork patent). Accordingly, Appellant respectfully submits that the Examiner has

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not provided evidence in the Bork patent that the portable computer 70 or PC 10, for example, does not have to be aware of the first protocol to be in communication with the device.

In fact, the portable computer 70 or PC 10 is aware of the Bluetooth protocol (which is alleged to be the first protocol). FIG. 19 of the Bork patent is substantially relied upon as evidence by the Examiner; however, it is shown in FIG. 19 of the Bork patent that PC HCI Library of the portable computer 70 is in communication with Bluetooth HC of cradle 46; and USB Function Driver of the portable computer 70 is in communication with Bluetooth USB Firmware. FIG. 19 of the Bork patent suggests that the portable computer 70 is aware of the Bluetooth protocol.

FIG. 18 of the Bork patent also provides rebuttal evidence that the portable computer 70 or PC 10 is aware of the Bluetooth protocol during communications with the device. According to the Bork patent, "FIG. 18 illustrates a high level block diagram of the relevant portions of personal computer 10 that enable the computer to communicate with the Bluetooth radio in cradle 46". In particular, FIG. 18 illustrates a Bluetooth Adviser 68. Appellant respectfully submit that, if the computer 10 has a Bluetooth Adviser, then the computer 10 is aware of the Bluetooth protocol.

The specification of the Bork patent with respect to FIG. 18 also states the following:

Computer 10 also requires Bluetooth profiles 60, such as found in the Bluetooth Profile Specification, which can be found at www.Bluetooth.com or www.Bluetooth.net, hereby incorporated by reference, which are applications that insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility at the application layer so that if, for example, data synchronization is required, the computer knows how to do data synchronization with mobile device 54 (see for example, FIG. 21 in the Profile Stack section on page 171 of the Bluetooth Profile Specification). Computer 10 can be enhanced by the addition of an application 60 that enables the user to configure, control, and use all Bluetooth devices that are connected to a computer (e.g., application such as Bluetooth Advisor—see WinHEC 99 White Paper submitted herewith, or Bluetooth Neighborhood—see also www.Bluetooth.net). In the event that computer 10 is to be coupled to cradle 46 via a Universal Serial Bus "USB", the computer 10 also requires

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a USB driver 62 in addition to a PC operating system 61, such as Microsoft's Windows 98.

The Bork patent at col. 6, lines 26-36 (bold and underlining of "Computer 10" and "requires" added for emphasis). Appellant respectfully submits that, since the computer 10 requires Bluetooth profiles, the computer 10 is aware of the Bluetooth protocol.

Applicant respectfully submits that, since PC 10 requires (i.e., it is not optional so as to permit the Examiner's alleged characterization of the Bluetooth USB Firmware as set forth in the Final Office Action at page 4) Bluetooth profiles 60 and other Bluetooth applications to "insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility at the application layer", the electronic system (which is alleged to be the PC 10) has to be aware of the first protocol (which is alleged to be the Bluetooth protocol).

To maintain an anticipation rejection, each and every element as set forth in independent claims 1, 11, 16 and 24 must be described in the Bork patent. For at least the above reasons, Appellant respectfully submits that each and every element as set forth in independent claims 1, 11, 16 and 24 is not described in the Bork patent.

It is therefore respectfully requested that the Board reverse the rejection with respect to claims 1-5, 10-13, 16-20 and 24-27.

VI. Group VI: Claims 7, 22 and 28

Claims 7, 22 and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Bork patent.

The arguments made above in section I with respect to claims 1, 16 and 24, from which claims 7, 22 and 28 depend, respectively, are incorporated herein and made with respect to claims 7, 22 and 28. For at least these reasons, the Board is urged to reverse the rejection with respect to claims 7, 22 and 28.

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In the Final Office Action at page 3, the Examiner alleges that "Re Claims 7, 22, 28, the USB device controller coupled to the inherently includes the USB protocol stack".

Appellant respectfully challenges the assertion that the elements in claims 7, 22 and 28 in combination with claims 1, 16 and 24, respectively, are all inherent. Appellant believes that the Examiner improperly applied the doctrine of inherency for the reasons stated above as set forth in Section II, which is incorporated herein in its entirety.

Appellant respectfully submits that the elements recited in the claims 7, 22 and 28 might be probable or possible elements, but are not necessary elements. In other words, if components and relationships other than the elements recited in the claims could be used, then the doctrine of inherency does not apply.

Claim 7 recites, in part, "wherein the system communication module further includes a USB protocol stack, the interface unit further including a USB interface operatively connected to the USB protocol stack". It is not all necessary that a system communication module necessarily include a USB protocol stack. Claim 1 from which claim 7 depends is not so limited as to be used only with a USB protocol.

Claim 22 recites, in part, "wherein the system communication module further includes a USB protocol stack, the interface unit further including a USB interface operatively connected to the USB protocol stack". It is not all necessary that a system communication module necessarily include a USB protocol stack. Claim 16 from which claim 22 depends is not so limited as to be used only with a USB protocol.

Claim 28, recites, in part, "wherein the system communication routine utilizes a USB protocol stack in processing information received from the electronic system and translated data received from the translation routine". It is not at all necessary that a system communication routing always utilize a USB protocol stack. Claim 24 from which claim 28 depends is not so limited as to be utilize only a USB protocol stack.

For at least the above reasons, it is respectfully requested that the Board reverse the rejection based on the inherency doctrine or that the Board compel the Examiner to either produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, compel the Examiner to

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provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).